

70/Petition
(CFR 1.144)

49986-0504 (RSID 1-330)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re application of:

Zhongming Yu

Group Art Unit No.: 2854

Examiner: Charles H. Nolan, Jr.

11-20-03

L. Spruell

Serial No.: 09/823,803

Filed on: March 30, 2001

For: MULTIPLE PAGE-RANGE PRINTER
SETTINGS

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PETITION UNDER 37 CFR § 1.144
FROM FINAL REQUIREMENT FOR RESTRICTION

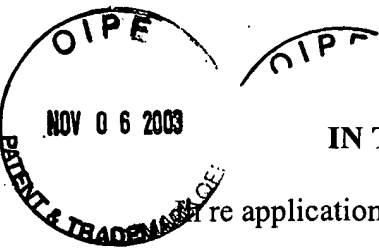
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR § 1.144, Applicant hereby petitions the Honorable Commissioner for Patents to review and withdraw the final requirement for restriction that has been entered by the Patent Office in respect of the above-identified application.

1. **Background:** In the Requirement for Restriction mailed on April 11, 2003 (see Exhibit 1, attached herewith), the Examiner made a three-way restriction of Claims 1-18 (Group I – class 400, subclass 61); Claims 19-36 (Group II – class 358, subclass 1.18); and Claims 37-42 (Group III – class 400, subclass 76). Applicant traversed the Examiner's requirement for restriction and requested reconsideration thereof in a paper filed on May 8, 2003 (see Exhibit 2, attached herewith). In the office action mailed on August 5, 2003, the Examiner made the requirement for restriction final (see Exhibit 3, attached herewith).

2. **Applicant is Entitled to File This Petition Under 37 CFR § 1.144:** Because the Applicant has filed a request for reconsideration of the requirement for restriction, and because



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the requirement has been made final, Applicant is entitled to submit this Petition under 37 CFR § 1.144 for review of the final requirement for restriction.

3. **Standard for Justifying a Restriction Requirement:** According to the MPEP, “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions” MPEP § 803. The Examiner asserts that it would be a serious burden for the Examiner to conduct a search in respect of all three claim groups. See Exhibit 3, at page 2, paragraph 1.

4. **The Claim Groups Merely Have Different Preambles, and Examination of the Claim Groups Together Would Not Cause a Serious Burden on the Examiner:** As stated above, the Requirement for Restriction issued on April 11, 2003 asserts a three-way restriction of Claims 1-18 (Group I – class 400, subclass 61); Claims 19-36 (Group II – class 358, subclass 1.18); and Claims 37-42 (Group III – class 400, subclass 76). A copy of the claims as filed can be found in Exhibit 4, which is attached herewith.

Each of these groups of claims contains the identical steps with the only difference being the context stated in the preamble. Although the preambles of the claim groups differ, the limitations in each of the claim groups are the same. Specifically, the Group I claims are recited in the context of a method for printing, the Group II claims are recited in the context of a computer-readable medium for printing and the Group III claims are recited in the context of a system for printing. For example, independent method Claim 1 recites “A method for printing an electronic document, the method comprising:” followed by a set of steps. Independent computer-readable medium Claim 19 recites “A computer-readable medium carrying one or more sequences of instructions for printing an electronic document, wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors

to perform:" followed by the identical set of steps. Independent system Claim 37 recites "A system for printing an electronic document, comprising: one or more processors; one or more memories coupled to the one or more processors; and one or more sequences of instructions stored in the one or more memories, wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors to perform the steps of:" followed by the identical set of steps.

Because the claims recite printing an electronic document, a computer-readable medium for printing an electronic document and a system for printing an electronic document with the identical steps, it is respectfully submitted that a single search can be performed covering all claims without serious burden on the Examiner. In view of the foregoing, review and withdrawal of the requirement for restriction is respectfully requested.

5. Method Claims and Computer-Readable Medium Claims that Recite Identical Steps Are Commonly Examined Together: Applicant submits that it is common knowledge and practice in the field of patents that method claims and computer-readable medium claims that recite identical steps are examined together, and are not subject to restriction requirements. In this regard, MPEP § 2106, which concerns the examination of computer inventions, states that "[w]hen a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim." See MPEP § 2106, IV.B.1(a), third paragraph. Therefore, claim groups I and II should only constitute a single claim group. Applicant further submits that it is common knowledge and practice that apparatus or system claims that recite an apparatus or system to implement such method claims and computer-readable medium claims are also examined together with the method and computer-readable medium claims, and no restriction requirement is made.

6. **The Examiner's Search Should Not be Based on the Preamble:** In the Office Action that was mailed on August 5, 2003, the Examiner asserts that the different printing contexts set forth in the preambles of the independent claims necessitates separate searches by the Examiner because "the preamble establishes where the search will occur." (Office Action at page 2, first paragraph). Applicant submits that the Examiner's assertion is incorrect. Applicant has reviewed the relevant sections of the MPEP which concern searching, and Applicant is unable to find any authority for the proposition that an Examiner must begin a search based on a claim preamble. Rather, the Examiner "should be fully aware of what the claims do *not* call for, as well as what they do require." See MPEP 904.01, which concerns the "Analysis of Claims" in the context of searching. It is a well-established rule that, in general, a preamble does not limit the scope of a claim. See IMS Tech., Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1434, 54 USPQ2d 1129, 1137 (Fed. Cir. 2000) (holding that preamble phrase "control apparatus" does not limit claim scope when it merely gives a descriptive name to the claimed invention), cited with approval in Storage Technology Corp. v. Cisco Systems, Inc., 329 F.3d 823 (Fed. Cir. 2003). Therefore, because a claim is not limited in scope by a preamble, the preamble is an item that is "not call[ed] for" (e.g., not required) in a claim. Therefore, a preamble should not be considered by the Examiner in a search, let alone be the starting point for a search. The search should be based on the claim limitations, not the preamble. Because all of the independent claims in the application (i.e., claims 1, 19 and 37) all have the same limitations, they can be searched together, and there is no serious burden on the Examiner.

7. **The Examiner's Classifications of the Claim Groups Appear to be Arbitrary:** Applicant submits that the Examiner's decision to classify independent claims 1, 19 and 37 separately appears to be an arbitrary decision. The claims recite the same limitations, but claim, respectively, a method, a computer readable medium and a system. It is very common for a

patent application to include all three of these types of claims. Therefore, it seems unusual for the Examiner to classify these claims separately, given that they recite the identical steps. In fact, in U.S. Patent No. 6,632,035 to Kawamoto for a "Print Control Apparatus and Method" (see Exhibit 5, attached hereto), which was examined by the same Examiner that made the restriction requirement in this case, the Examiner allowed claims relating to printing that involved: (1) an information processing apparatus, (2) a printing control method, (3) a program for causing a computer to perform printing control, (4) a computer-readable storage medium storing a program for causing a computer to perform printing control, (5) a display control apparatus, (6) a program for causing a computer to perform display control, and (7) many other apparatuses, programs and computer-readable storage mediums, without restricting such into separate claim groups.

Therefore, it is unclear why the Examiner is now asserting that method claims, system claims and computer-readable-medium claims must be restricted into separate claim groups.

In particular, the Examiner's assertion that subclasses 400/61 (claim group I) and 400/76 (claim group III) must be searched separately appears to be arbitrary. In Patent No. 6,632,035, which is mentioned above, the Examiner searched in both of these subclasses, but did not make a restriction requirement. Applicant is aware of many patents in which both of these subclasses have been searched without a restriction requirement being made.

8. **A *Prima Facie* Assumption, Based on Separate Classifications, That a Search Would Be a Serious Burden on the Examiner is Rebuttable:** It is true that the Examiner only needs to show a separate classification as evidence of a separate field of search. However, separate classification and a separate field of search are only "*prima facie*" showings of serious burden that "may be rebutted." See MPEP § 803.01. In other words, a separate classification and field of search are at best rebuttable evidence of a serious burden on the Examiner. If there is nonetheless no serious burden in examining the additional claim groupings (because, for

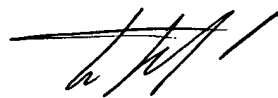
example, they have nearly the same search as argued in the original response to the restriction), the restriction is still improper despite the separate classification. Therefore, even if, assuming *arguendo*, the claims can be classified separately, restriction is not required because, based on the reasons presented above, there is no serious burden on the Examiner.

Based on the foregoing, Applicant respectfully requests that the Honorable Commissioner for Patents withdraw the final requirement for restriction that has been entered in this case. The Honorable Commissioner for Patents is invited to telephone the undersigned at (408) 414-1210 to discuss any issue that may advance prosecution.

The fee believed to be due specifically in connection with this petition is enclosed. To the extent necessary, Applicants petition for an extension of time under 37 C.F.R. § 1.136. The Commissioner is authorized to charge any fee that may be due in connection with this petition to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER, LLP



Thomas J. Treutler
Registration No. 51,126

Dated: November 3, 2003

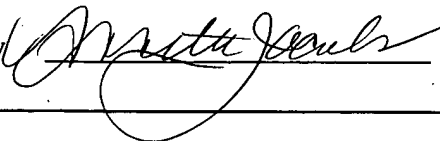
1600 Willow Street
San Jose, California 95125-5106
Tel: (408) 414-1080 ext. 206
Fax: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on November 3, 2003

by





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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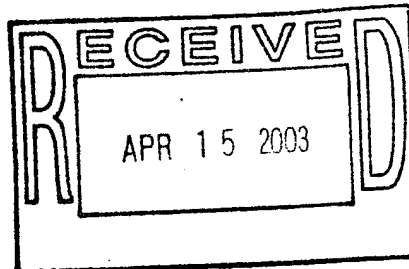
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,803	03/30/2001	Zhongming Yu	49986-0504	7413

29989 7590 04/11/2003

HICKMAN PALERMO TRUONG & BECKER, LLP
1600 WILLOW STREET
SAN JOSE, CA 95125



EXAMINER

NOLAN JR, CHARLES H

ART UNIT PAPER NUMBER

2854

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HICKMAN PALERMO TRUONG & BECKER
Atty Docket # 49986-0504 Initials R
Atty Paralegal SS U.S. ✓
Foreign _____ Country _____
Action Docket OA W/R R.
Reminders: 2 mo _____
1 mo. _____ 2 wk. 4/25/03
Action Due Date 5/11/03

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Office Action Summary



Application No.

09/823,803

Applicant(s)

YU, ZHONGMING

Examiner

Charles H Nolan, Jr.

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a method for printing, classified in class 400, subclass 61.
 - II. Claims 19-36, drawn to a computer readable medium, classified in class 358, subclass 1.18.
 - III. Claims 37-42, drawn to a system for printing, classified in class 400, subclass 76.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, Invention I can be used in CD label printer.
3. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, Invention II can be used in CD label printer.

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4. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, Invention II may be used in a CD recorder.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H Nolan, Jr. whose telephone number is 703-308-0961. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

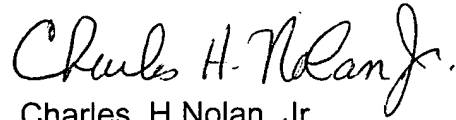
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-5841 for After Final communications.

Application/Control Number: 09/823,803

Page 4

Art Unit: 2854

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Charles H Nolan, Jr.
Examiner
Art Unit 2854

CHN
April 9, 2003



UNITED STATES
PATENT AND
TRADEMARK OFFICE

FEB 20 2003

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

Dear Patent Business Customer:

The United States Patent and Trademark Office ("Office") is now permitting and encouraging applicants to voluntarily submit amendments in a revised format as set forth in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, Off. Gaz. Pat. Office (February 25, 2003), currently available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>. The revised format permits amendments to the specification and claims to be made in a single marked-up version; the requirement for a clean version is eliminated. Attached, you will find a flyer with information and instructions regarding the procedures to be used to comply with the revised format. The flyers are being inserted with out-going Office actions mailed during the period of February 20, 2003 - March 31, 2003.

The revised amendment format is essentially the same as the amendment format for the specification, claims, and drawings that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. This proposed revision and others necessary to facilitate a gradual transition to the use of an Electronic File Wrapper (EFW) will be set forth in a Notice of Proposed Rule making (NPR), expected to be published by March 2003. After consideration of public comments, the Office anticipates adopting a revision to § 1.121, following publication of a Notice of Final Rule making (NFR), expected by June 2003, at which point compliance with revised § 1.121 will be mandatory.

The Office will continue to accept your amendment submissions in the revised format during the voluntary period, which will extend up to the effective date of final revisions to § 1.121. The Office also encourages your feedback on the proposed revised amendment format and other changes set forth in the NPR, expected to be published by March 2003.

For assistance: Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA), Legal Advisors Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). Alternately, you may send e-mail to "Patent Practice", the OPLA e-mail address that has been established for receiving queries and questions about patent practice and procedures or telephone OPLA at (703) 305-1616.

Nicholas P. Godici
Commissioner for Patents

Attachment: Flyer entitled: *Revised Notice* AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT*



UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Zhongming YU)

Serial No.: 09/823,803)

Filing Date: March 30, 2001)

Examiner: C. H. Nolan, Jr.

Art Unit: 2854

For: MULTIPLE PAGE-RANGE PRINTER SETTINGS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF REQUIREMENT FOR RESTRICTION

Sir:

In reply to the Requirement for Restriction mailed on April 11, 2003, Applicant hereby requests reconsideration and withdrawal of the Requirement for Restriction for at least the following reasons. The Requirement for Restriction asserts a three-way restriction of Claims 1-18 (Group I); Claims 19-36 (Group II); and Claims 37-42 (Group III). Each of these groups of claims contains the identical steps with the only difference being the context. Specifically, the Group I claims are recited in the context of a method for printing, the Group II claims are recited in the context of a computer-readable medium for printing and the Group III claims are recited in the context of a system for printing. For example, independent method Claim 1 recites "A method for printing an electronic document, the method comprising:" followed by a set of steps. Independent computer-readable medium Claim 19 recites "A computer-readable medium carrying one or more sequences of instructions for printing an electronic document, wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors to perform:" followed by the identical set of steps. Independent system Claim 37 recites "A system for printing an electronic document, comprising: one or more

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processors; one or more memories coupled to the one or more processors; and one or more sequences of instructions stored in the one or more memories, wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors to perform the steps of:" followed by the identical set of steps. Since all of the claims recite a method for printing an electronic document, computer-readable medium for printing an electronic document or system for printing an electronic document with the identical steps, it is respectfully submitted that a single search can be performed covering all claims without serious burden on the Examiner. "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" MPEP §803. In view of the foregoing, reconsideration and withdrawal of the requirement for restriction is respectfully requested.

Applicant hereby provisionally elects with traverse Claims 1-18 for examination. If there are any additional charges, please charge them to Deposit Account No. 50-1302. The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Edward A. Becker
Reg. No. 37,777

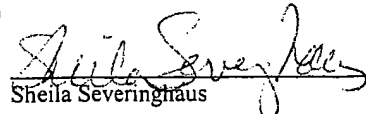
1600 Willow Street
San Jose, CA 95125
(408) 414-1204
Date: May 8, 2003
Facsimile: (408) 414-1076

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on May 8, 2003

by

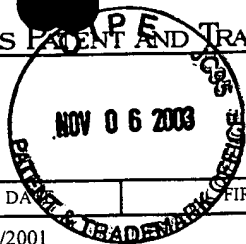

Sheila Severinghaus



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,803	03/30/2001	Zhongming Yu	49986-0504	7413

29989 7590 08/05/2003

HICKMAN PALERMO TRUONG & BECKER, LLP
1600 WILLOW STREET
SAN JOSE, CA 95125

EXAMINER

NOLAN JR, CHARLES H

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 08/05/2003

AUG - 8 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HICKMAN PALERMO TRUONG & BECKER
Atty Docket # 49986-0504 Initials R
Atty Paralegal SS U.S. ☒
Foreign _____ Country _____
Action Docket OA
Reminders: 2 mo 9/5/03
1 mo. 10/5/03 2 wk. 10/18/03
Action Due Date 11/5/03 3 mos; 2/5/04 - 6 mos

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DATA ENTRY

Office Action Summary



Application No.

09/823,803

Applicant(s)

YU, ZHONGMING

Examiner

Charles H Nolan, Jr.

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
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- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
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Disposition of Claims

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- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

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- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Claims 1-18 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the bodies of the claims recite similar subject matter. This is not found persuasive because the preamble establishes where the search will occur. It would be a serious burden for the Examiner to search every conceivable area for selecting specific pages of data to be printed, a computer memory with similar instructions and all such machines that carry out the method.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-10,12-18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Whitmarsh US 202/0101608 A1, hereafter "608."

How Claims 1-18 are being interpreted:

It is noted that the first, second and third paper sources/characteristics/types are not necessarily different. Likewise, the first ,second and third paper ranges are not

necessarily different. Additionally, any further recitations of a first, second and third have been interpreted as a repeated process. The Examiner has interpreted Claim 1-18 as a repeated process of the same tray/characteristics/inks and pages. The Examiner has interpreted Claims 1-18 using the broadest reasonable interpretation. See, e.g., *In re Yamamoto*, 222 USPQ 934,936-937 (Fed. Cir. 1984).

With respect to Claims 1-5,12-13,14-15, '608 teaches the selection of a paper sources/characteristics in figure 9 and the selection of a page ranges in page 7 at element 72 and the printer 18b on the front page diagram, the printing of the paper in at least one ink color by either printer 18b or 18c. With respect to Claim 6, '608 teaches the simplex and duplex modes in figure 9 at element 80e. With respect to Claims 7-10,16-18, '608 teaches the user interface in figure 9 and the receiving and transmitting steps on the front page diagram and the selection of media types in figure 9 and section [0041-0042].

Allowable Subject Matter

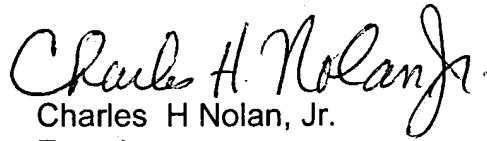
4. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H Nolan, Jr. whose telephone number is 703-308-0961. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

Art Unit: 2854

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-5841 for After Final communications.

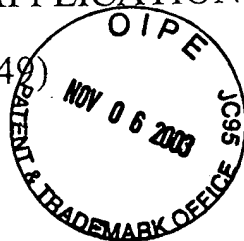
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Charles H Nolan, Jr.
Examiner
Art Unit 2854

CHN
July 27, 2003

INFORMATION DISCLOSURE CITATION IN AN APPLICATION

(PTO-1449)



ATTY. DOCKET NO.
49986-0504

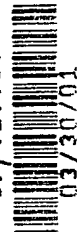
SERIAL NO.,
~~Not Yet Assigned~~
09/823,803

APPLICANT
Zhongming YU

FILING DATE
March 30, 2001

GROUP 2854
~~Not Yet Assigned~~

1033 U.S. PTO
09/023803



U.S. PATENT DOCUMENTS

EXAMINER'S INITIALS	PATENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE

FOREIGN PATENT DOCUMENTS

EXAMINER'S INITIALS	PATENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	Translation	
						Yes	No

OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

CH	S. Strasen, et al., "ISO/IEC 10180 Information Technology-Text Communication-Standard Page Description Language (SPDL)", December 30, 1993, SPDL Project Editors, pp. 11-1, 13-2 - 13-5.
EXAMINER	DATE CONSIDERED
NOLAN	8-31-02

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

Notice of References Cited



Application/Control No.

09/823,803

Applicant(s)/Patent Under
Reexamination
YU, ZHONGMING

Examiner

Charles H Nolan, Jr.

Art Unit

2854

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,448,691	09-1995	Motoyama, Tetsuro	715/525
	B	US-2002/0101608	08-2002	Whitmarsh, Michael D.	358/1.15
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

CLAIMS

What is claimed is:

- 1 1. A method for printing an electronic document, the method comprising:
2 selecting a first paper source for printing a first page range of one or more
3 pages of said electronic document;
4 selecting a second paper source for printing a second page range of one or
5 more pages of said electronic document;
6 selecting a third paper source for printing a third page range of one or more
7 pages of said electronic document; and
8 transmitting, to a printing device, information that identifies said first, second
9 and third paper sources for printing said first, second and third page
10 ranges of one or more pages of said electronic document.
- 1 2. The method as recited in Claim 1, further comprising the steps of:
2 receiving said information that identifies said first, second and third paper
3 sources at said printing device; and
4 generating at said printing device a printed copy of said electronic document
5 that includes said first, second and third page ranges; wherein said
6 first page range is printed on media from said first paper source, said
7 second page range is printed on media from said second paper source,
8 and said third page range is printed on media from said third paper
9 source.
- 1 3. A method for printing an electronic document, the method comprising:
2 selecting a first print characteristic for printing a first page range of one or
3 more pages of said electronic document;

4 selecting a second print characteristic for printing a second page range of one
5 or more pages of said electronic document; and
6 transmitting, to a printing device, information that identifies said first and
7 second print characteristics for printing said first and second page
8 ranges of one or more pages of said electronic document.

1 4. The method as recited in Claim 3, further comprising the steps of:
2 receiving at said printing device, said information that identifies said first and
3 second print characteristics; and
4 generating at said printing device a printed copy of said electronic document
5 that includes said first and second page ranges; wherein said first
6 page range is printed using said first print characteristics and said
7 second page range is printed using said second print characteristics.

1 5. The method as recited in Claim 3, wherein:
2 the step of selecting a first print characteristic includes the step of selecting a
3 first ink color for printing said first page range of one or more pages
4 of said electronic document; and
5 the step of selecting a second print characteristic includes the step of
6 selecting a second ink color for printing said first page range of one
7 or more pages of said electronic document;
8 wherein said first ink color and said second ink color are distinct ink colors.

1 6. The method as recited in Claim 3, wherein:
2 the step of selecting a first print characteristic includes the step of selecting a
3 simplex mode for printing said first page range of one or more pages
4 of said electronic document; and

5 the step of selecting a second print characteristic includes the step of
6 selecting a duplex mode for printing said first page range of one or
7 more pages of said electronic document.

1 7. A method for printing an electronic document, the method comprising:
2 displaying a user interface that identifies a set of one or more media types
3 that are available for printing pages of the electronic document;
4 receiving input that selects a first media type from said set of one or more
5 media types; and
6 transmitting, to a printing device, a set of first print information that
7 identifies said first media type for printing one or more pages of said
8 electronic document.

1 8. The method as recited in Claim 7, further comprising the steps of:
2 receiving said set of first print information that identifies said first media
3 type at said printing device; and
4 generating at said printing device, a printed copy of one or more pages of
5 said electronic document using said first media type.

1 9. The method of Claim 7, wherein:
2 the set of media types includes two or more media types that are available for
3 printing pages of the electronic document; and
4 the method further comprising the steps of,
5 receiving input that selects a second media type from said set of two or more
6 media types; and
7 the step of transmitting further includes the step of transmitting to said
8 printing device, a set of second print information that identifies said

9 second media type for printing one or more pages of said electronic
10 document.

1 10. The method as recited in Claim 9, further comprising the steps of:
2 receiving said set of second print information that identifies said second
3 media type at said printing device; and
4 generating at said printing device, a printed copy of one or more pages of
5 said electronic document using said second media type.

1 11. The method of Claim 9, wherein the steps of transmitting said set of first and
2 second print information includes the step of transmitting to said printing
3 device, said set of first and second print information in a single print request.

1 12. A method for printing an electronic document, the method comprising:
2 selecting a first media type for printing a first page range of one or more
3 pages of said electronic document;
4 selecting a second media type for printing a second page range of one or
5 more pages of said electronic document; and
6 transmitting, to a printing device, information that identifies said first and
7 second media types for printing said first and second page ranges of
8 one or more pages of said electronic document.

1 13. The method as recited in Claim 12, further comprising the steps of:
2 receiving said information that identifies said first and second media types at
3 said printing device; and
4 generating at said printing device, a printed copy of said electronic document
5 that includes said first and second page ranges; wherein said first

6 page range is printed on media of said first media type and said
7 second page range is printed on media of said second media type.

1 14. A method for printing an electronic document, the method comprising:
2 transmitting to a printing device a request from a client for delivery of a set
3 of print attributes that are available for printing said electronic
4 document on said printing device;
5 receiving user interface data that identifies the set of print attributes that are
6 available for printing said electronic document on said printing
7 device;
8 receiving input that indicates a selection of one or more print attributes from
9 said set of print attributes; and
10 transmitting information identifying the selection of said one or more print
11 attributes from said client to said printing device.

1 15. The method as recited in Claim 14, further comprising the steps of:
2 receiving said information that identifies said one or more print attributes at
3 said printing device; and
4 generating at said printing device, a printed copy of said electronic document
5 based on said information identifying said selection of said one or
6 more print attributes.

1 16. A method for printing an electronic document on a printing device, the
2 method comprising:
3 receiving a request for delivery of a set of print attributes that are available
4 for printing said electronic document on said printing device;

5 generating user interface data that identifies the set of print attributes that are
6 available for printing said electronic document on said printing
7 device; and
8 transmitting, to a client, said user interface data for displaying the set of print
9 attributes that are available for printing said electronic document on
10 said printing device.

1 17. The method as recited in Claim 16, further comprising the steps of:
2 receiving print information that identifies at least one of said one or more
3 print attributes; and
4 generating at said printing device, a printed copy of one or more pages of
5 said electronic document based on said print information.

1 18. The method as recited in Claim 16, further comprising the steps of:
2 transmitting to said printing device a request from a client for delivery of said
3 set of print attributes that are available for printing said electronic
4 document on said printing device;
5 receiving user interface data at said client that identifies the set of print
6 attributes that are available for printing said electronic document on
7 said printing device; and
8 transmitting print information that identifies at least one of said said one or
9 more print attributes.

1 19. A computer-readable medium carrying one or more sequences of instructions
2 for printing an electronic document, wherein execution of the one or more
3 sequences of instructions by one or more processors causes the one or more
4 processors to perform:

5 selecting a first paper source for printing a first page range of one or more
6 pages of said electronic document;
7 selecting a second paper source for printing a second page range of one or
8 more pages of said electronic document;
9 selecting a third paper source for printing a third page range of one or more
10 pages of said electronic document; and
11 transmitting, to a printing device, information that identifies said first, second
12 and third paper sources for printing said first, second and third page
13 ranges of one or more pages of said electronic document.

1 20. The computer-readable medium as recited in Claim 19, further comprising
2 instructions for performing the steps of:
3 receiving said information that identifies said first, second and third paper
4 sources at said printing device; and
5 generating at said printing device a printed copy of said electronic document
6 that includes said first, second and third page ranges; wherein said
7 first page range is printed on media from said first paper source, said
8 second page range is printed on media from said second paper source,
9 and said third page range is printed on media from said third paper
10 source.

1 21. A computer-readable medium carrying one or more sequences of instructions
2 for printing an electronic document, wherein execution of the one or more
3 sequences of instructions by one or more processors causes the one or more
4 processors to perform:
5 selecting a first print characteristic for printing a first page range of one or
6 more pages of said electronic document;

7 selecting a second print characteristic for printing a second page range of one
8 or more pages of said electronic document; and
9 transmitting, to a printing device, information that identifies said first and
10 second print characteristics for printing said first and second page
11 ranges of one or more pages of said electronic document.

1 22. The computer-readable medium as recited in Claim 21, further comprising
2 instructions for performing the steps of:
3 receiving at said printing device, said information that identifies said first and
4 second print characteristics; and
5 generating at said printing device a printed copy of said electronic document
6 that includes said first and second page ranges; wherein said first
7 page range is printed using said first print characteristics and said
8 second page range is printed using said second print characteristics.

1 23. The computer-readable medium as recited in Claim 21, wherein:
2 the step of selecting a first print characteristic includes the step of selecting a
3 first ink color for printing said first page range of one or more pages
4 of said electronic document; and
5 the step of selecting a second print characteristic includes the step of
6 selecting a second ink color for printing said first page range of one
7 or more pages of said electronic document;
8 wherein said first ink color and said second ink color are distinct ink colors.

1 24. The computer-readable medium as recited in Claim 21, wherein:
2 the step of selecting a first print characteristic includes the step of selecting a
3 simplex mode for printing said first page range of one or more pages
4 of said electronic document; and

5 the step of selecting a second print characteristic includes the step of
6 selecting a duplex mode for printing said first page range of one or
7 more pages of said electronic document.

1 25. A computer-readable medium carrying one or more sequences of instructions
2 for printing an electronic document, wherein execution of the one or more
3 sequences of instructions by one or more processors causes the one or more
4 processors to perform:
5 displaying a user interface that identifies a set of one or more media types
6 that are available for printing pages of the electronic document;
7 receiving input that selects a first media type from said set of one or more
8 media types; and
9 transmitting, to a printing device, a set of first print information that
10 identifies said first media type for printing one or more pages of said
11 electronic document.

1 26. The computer-readable medium as recited in Claim 25, further comprising
2 instructions for performing the steps of:
3 receiving said set of first print information that identifies said first media
4 type at said printing device; and
5 generating at said printing device, a printed copy of one or more pages of
6 said electronic document using said first media type.

1 27. The computer-readable medium of Claim 25, wherein:
2 the set of media types includes two or more media types that are available for
3 printing pages of the electronic document; and
4 the computer-readable medium further comprising instructions for
5 performing the steps of,

6 receiving input that selects a second media type from said set of two or more
7 media types; and
8 the step of transmitting further includes the step of transmitting to said
9 printing device, a set of second print information that identifies said
10 second media type for printing one or more pages of said electronic
11 document.

1 28. The computer-readable medium as recited in Claim 27, further comprising
2 instructions for performing the steps of:
3 receiving said set of second print information that identifies said second
4 media type at said printing device; and
5 generating at said printing device, a printed copy of one or more pages of
6 said electronic document using said second media type.

1 29. The computer-readable medium of Claim 27, wherein the steps of
2 transmitting said set of first and second print information includes the step of
3 transmitting to said printing device, said set of first and second print
4 information in a single print request.

1 30. A computer-readable medium carrying one or more sequences of instructions
2 for printing an electronic document, wherein execution of the one or more
3 sequences of instructions by one or more processors causes the one or more
4 processors to perform:
5 selecting a first media type for printing a first page range of one or more
6 pages of said electronic document;
7 selecting a second media type for printing a second page range of one or
8 more pages of said electronic document; and

9 transmitting, to a printing device, information that identifies said first and
10 second media types for printing said first and second page ranges of
11 one or more pages of said electronic document.

1 31. The computer-readable medium as recited in Claim 30, further comprising
2 instructions for performing the steps of:
3 receiving said information that identifies said first and second media types at
4 said printing device; and
5 generating at said printing device, a printed copy of said electronic document
6 that includes said first and second page ranges; wherein said first
7 page range is printed on media of said first media type and said
8 second page range is printed on media of said second media type.

1 32. A computer-readable medium carrying one or more sequences of instructions
2 for printing an electronic document, wherein execution of the one or more
3 sequences of instructions by one or more processors causes the one or more
4 processors to perform:
5 transmitting to a printing device a request from a client for delivery of a set
6 of print attributes that are available for printing said electronic
7 document on said printing device;
8 receiving user interface data that identifies the set of print attributes that are
9 available for printing said electronic document on said printing
10 device;
11 receiving input that indicates a selection of one or more print attributes from
12 said set of print attributes; and
13 transmitting information identifying the selection of said one or more print
14 attributes from said client to said printing device.

1 33. The computer-readable medium as recited in Claim 32, further comprising
2 instructions for performing the steps of:
3 receiving said information that identifies said one or more print attributes at
4 said printing device; and
5 generating at said printing device, a printed copy of said electronic document
6 based on said information identifying said selection of said one or
7 more print attributes.

1 34. A computer-readable medium carrying one or more sequences of instructions
2 for printing an electronic document on a printing device, wherein execution
3 of the one or more sequences of instructions by one or more processors
4 causes the one or more processors to perform:
5 receiving a request for delivery of a set of print attributes that are available
6 for printing said electronic document on said printing device;
7 generating user interface data that identifies the set of print attributes that are
8 available for printing said electronic document on said printing
9 device; and
10 transmitting, to a client, said user interface data for displaying the set of print
11 attributes that are available for printing said electronic document on
12 said printing device.

1 35. The computer-readable medium as recited in Claim 34, further comprising
2 instructions for performing the steps of:
3 receiving print information that identifies at least one of said one or more
4 print attributes; and
5 generating at said printing device, a printed copy of one or more pages of
6 said electronic document based on said print information.

1 36. The computer-readable medium as recited in Claim 34, further comprising
2 instructions for performing the steps of:
3 transmitting to said printing device a request from a client for delivery of said
4 set of print attributes that are available for printing said electronic
5 document on said printing device;
6 receiving user interface data at said client that identifies the set of print
7 attributes that are available for printing said electronic document on
8 said printing device; and
9 transmitting print information that identifies at least one of said said one or
10 more print attributes.

1 37. A system for printing an electronic document, comprising:
2 one or more processors;
3 one or more memories coupled to the one or more processors; and
4 one or more sequences of instructions stored in the one or more memories,
5 wherein execution of the one or more sequences of instructions by
6 one or more processors causes the one or more processors to perform
7 the steps of:
8 selecting a first paper source for printing a first page range of one or
9 more pages of said electronic document;
10 selecting a second paper source for printing a second page range of
11 one or more pages of said electronic document;
12 selecting a third paper source for printing a third page range of one or
13 more pages of said electronic document; and
14 transmitting, to a printing device, information that identifies said first,
15 second and third paper sources for printing said first, second

16 and third page ranges of one or more pages of said electronic
17 document.

1 38. A system for printing an electronic document, comprising:
2 one or more processors;
3 one or more memories coupled to the one or more processors; and
4 one or more sequences of instructions stored in the one or more memories,
5 wherein execution of the one or more sequences of instructions by
6 one or more processors causes the one or more processors to perform
7 the steps of:
8 selecting a first print characteristic for printing a first page range of
9 one or more pages of said electronic document;
10 selecting a second print characteristic for printing a second page
11 range of one or more pages of said electronic document; and
12 transmitting, to a printing device, information that identifies said first
13 and second print characteristics for printing said first and
14 second page ranges of one or more pages of said electronic
15 document.

1 39. A system for printing an electronic document, comprising:
2 one or more processors;
3 one or more memories coupled to the one or more processors; and
4 one or more sequences of instructions stored in the one or more memories,
5 wherein execution of the one or more sequences of instructions by
6 one or more processors causes the one or more processors to perform
7 the steps of:

8 displaying a user interface that identifies a set of one or more media
9 types that are available for printing pages of the electronic
10 document;
11 receiving input that selects a first media type from said set of one or
12 more media types; and
13 transmitting, to a printing device, a set of first print information that
14 identifies said first media type for printing one or more pages
15 of said electronic document.

1 40. A system for printing an electronic document, comprising:
2 one or more processors;
3 one or more memories coupled to the one or more processors; and
4 one or more sequences of instructions stored in the one or more memories,
5 wherein execution of the one or more sequences of instructions by
6 one or more processors causes the one or more processors to perform
7 the steps of:
8 selecting a first media type for printing a first page range of one or
9 more pages of said electronic document;
10 selecting a second media type for printing a second page range of one
11 or more pages of said electronic document; and
12 transmitting, to a printing device, information that identifies said first
13 and second media types for printing said first and second page
14 ranges of one or more pages of said electronic document.

1 41. A system for printing an electronic document, comprising:
2 one or more processors;
3 one or more memories coupled to the one or more processors; and

4 one or more sequences of instructions stored in the one or more memories,
5 wherein execution of the one or more sequences of instructions by
6 one or more processors causes the one or more processors to perform
7 the steps of:
8 transmitting to a printing device a request from a client for delivery of
9 a set of print attributes that are available for printing said
10 electronic document on said printing device;
11 receiving user interface data that identifies the set of print attributes
12 that are available for printing said electronic document on said
13 printing device;
14 receiving input that indicates a selection of one or more print
15 attributes from said set of print attributes; and
16 transmitting information identifying the selection of said one or more
17 print attributes from said client to said printing device.

1 42. A system for printing an electronic document, comprising:
2 one or more processors;
3 one or more memories coupled to the one or more processors; and
4 one or more sequences of instructions stored in the one or more memories,
5 wherein execution of the one or more sequences of instructions by
6 one or more processors causes the one or more processors to perform
7 the steps of:
8 receiving a request for delivery of a set of print attributes that are
9 available for printing said electronic document on said
10 printing device;

11 generating user interface data that identifies the set of print attributes
12 that are available for printing said electronic document on said
13 printing device; and
14 transmitting, to a client, said user interface data for displaying the set
15 of print attributes that are available for printing said electronic
16 document on said printing device.

ABSTRACT OF THE DISCLOSURE

A method and system for printing an electronic document is disclosed. In one aspect, a first media type for printing a first page range of one or more pages of an electronic document is selected. A second media type for printing a second page range of one or more pages of the electronic document is also selected. Information that identifies the first and second media types for printing the first and second page ranges of one or more pages of the electronic document are transmitted to a printing device. In response to receiving the information, the printing device generates a printed copy of the electronic document that includes the first and second page ranges; the first page range being printed using the first media type and the second page range being printed using the second media type.